UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,224	03/27/2001	Kaoru Shimamura	122.1448	7933

21171 7590 07/21/2004		EXAMINER
STAAS & HALSEY LLP		HUTTON JR, WILLIAM D

SUITE 700	ART UNIT	PAPER NUMBER
1201 NEW YORK AVENUE, N.W.	2179	
WASHINGTON, DC 20005		

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/817,224	SHIMAMURA, KAORU	
	Examiner	Art Unit	
	Doug Hutton	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 December 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 March 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/01</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Priority

Receipt of papers submitted under 35 U.S.C. 119(a)-(d) is acknowledged. The

papers have been placed of record in the file.

Specification

The abstract of the disclosure is objected to because it exceeds 150 words in

length. Correction is required. See MPEP § 608.01(b).

Applicant's invention is difficult to determine and understand because the

specification appears to be a straight translation of a Japanese patent application. A

substitute specification in proper idiomatic English and in compliance with 37

CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied

by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9:

Claim 1 recites the limitation "a display unit displaying an external-character code registration screen *based on an external-character code table*" in Lines 4-6. Claim 9 recites the same limitation in Lines 6-8.

This limitation is indefinite because it is unclear how the "external-character code registration screen" is "***based***" on an "external-character code table." The "registration screen" appears to be an interactive user interface that is used to register "external characters" by associating "master codes" and "font codes." Thus, the "external-character code registration screen" is not "based" on an "external-character code table."

The limitation should be amended to accurately describe Applicant's invention.

Claims 2 and 10:

Claim 2 recites the limitation "a font selection screen selecting an external-character font of an external-character file" in Lines 4-5. Claim 10 recites the same limitation in Lines 5-7.

This limitation is indefinite because it is unclear how the "screen" "selects" an external-character font. Rather, the user uses the screen to register "external characters" by associating "master codes" and "font codes."

This same problem also occurs in Lines 8-9 of Claim 2. Claim 10 recites the same limitation in Lines 7-9.

The limitations should be amended to accurately describe Applicant's invention.

Claim 2 recites the limitations a "font selection screen" in Line 4, a "font selecting section" in Line 8 and an "external-character file creating section" in Lines 11-12. Claim 10 recites the same limitations.

These limitations are indefinite because it is unclear if the "screen" and the "sections" are parts of the "external-character code registration screen" (Claim 1, Lines 4-5) or separate from the "external-character code registration screen."

The limitations should be amended to particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 3:

Claim 3 recites the limitation a "character pattern reference file definition table defining a master-font file *in which a character pattern defined by the master code is referred to among a plurality of master-font files that are classified into types of designs of external-character fonts*" in Lines 3-8.

This limitation is indefinite because it is unclear how:

1) the "master code" "***defines***" a "character pattern an external-character font;" and

2) the "character pattern" is "***referred to***" "among a plurality of master-font files."

As currently worded, the examiner cannot determine what, precisely, the applicant has invented and is seeking to patent, and how the claim relates to and defines that invention.

The claim should be amended to particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 4:

Claim 4 recites the limitation a "character pattern registering section" in Lines 3-4.

This limitation is indefinite because it is unclear if the "section" is part of the "external-character code registration screen" (Claim 1, Lines 4-5) or separate from the "external-character code registration screen."

The limitation should be amended to particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 5:

Claim 5 recites the limitation "wherein the external-character code table lists character patterns in place of master codes" in Lines 2-3.

This limitation is indefinite because it is unclear if the "code table" replaces "master codes" with "character patterns" or merely lists the "character patterns" and the corresponding "master codes.

The limitation should be amended to particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 6:

Claim 6 recites the limitation a "character shape confirmation font file storing character patterns which makes it possible *to confirm character shapes of master codes, as another master font file*" in Lines 3-6.

This limitation is indefinite because it is unclear what is meant by the phrase "confirm character shapes of master codes, as another master font file." The "master code" is merely a number and appears to have no "character shape."

The limitation should be amended to particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al., Japanese Patent Publication No. 06259426.

Claim 1:

Yamaguchi discloses an external-character font creation system for creating external-character fonts (see Pages 1-68; more specifically, see "Abstract" on Page 1 –

Yamaguchi discloses a character processing system that "creates external-character fonts), the external-character font creation system comprising:

- a display unit (7, Figure 1) displaying an external-character code registration screen (see Page 12, third full paragraph – because the user registers external characters, the character processing system includes an "external-character code registration screen") based on an external-character code table that shows a correspondence between an external-character code of an external character to be registered and a master code (see Figures 8-10; see Page 9, third full paragraph through Page 11, second full paragraph – the character processing system discloses this limitation in that it registers fonts through a user interface by associating external character patterns, external character managing numbers, character codes and face types into a table); and

- an edit unit registering a master code corresponding to an external-character code in the external-character code table (see Figures 8-10; see Page 12, first full paragraph through Page 14, second full paragraph – the character processing system discloses this limitation in that it registers a character code corresponding to an external character managing number in a correlation table).

Claim 2:

Yamaguchi discloses the external-character font creation system according to Claim 1, the external-character font creation system further comprising:

- a font selection screen selecting an external-character font of an external-character file to be created based on a correspondence relationship between a master font and an external-character font (see Page 12, first full paragraph – the character processing system discloses this limitation in that it allows the user to select the face types that are to be registered);

- a font selecting section selecting a plurality of external-character fonts of the external-character file by using the font selection screen (see Page 11, second full paragraph – the character processing system discloses this limitation in that it registers two face types simultaneously); and

- an external-character file creating section creating an external-character file of the external-character font selected by the font selecting section (see Figure 10; see Page 12, first full paragraph through Page 14, second full paragraph – the character processing system discloses this limitation in that it creates a correlation table).

Claim 3:

Yamaguchi discloses the external-character font creation system according to Claim 1, the external-character font creation system further comprising a character pattern reference file definition table defining a master-font file in which a character pattern defined by the master code is referred to among a plurality of master-font files that are classified into types of designs of external-character fonts (see Figures 8 and 9; see Page 10, first and second paragraphs; see Page 11, first full paragraph through

Page 12, first partial paragraph – the character processing system discloses this limitation in that it includes both an external character file that is classified into external characters and symbols and a plurality of master font files).

Claim 4:

Yamaguchi discloses the external-character font creation system according to Claim 1, the external-character font creation system further comprising a character pattern registering section copying a character pattern from a master-font file into an external-character file based on a master code (see Figures 8-11; see Page 9, third full paragraph through Page 11, second full paragraph – the character processing system discloses this limitation in that it registers fonts through a user interface by associating external character patterns, external character managing numbers, character codes and face types into a table).

Claim 5:

Yamaguchi discloses the external-character font creation system according to Claim 1, wherein the external-character code table lists character patterns in place of master codes (see Figures 8-11; see Page 9, third full paragraph through Page 11, second full paragraph; see Page 12, first full paragraph through Page 14, second full paragraph – the character processing system discloses this limitation in that it registers fonts through a user interface by associating external character patterns, external character managing numbers, character codes and face types into a table; thus, the

"external-character code table" "lists character patterns in place of master codes" in that

it associates the external character patterns, external character managing numbers,

character codes and face types into a table).

Claim 6:

Yamaguchi discloses the external-character font creation system according to

Claim 3, the external-character font creation system further comprising a character

shape confirmation font file storing character patterns which makes it possible to

confirm character shapes of master codes, as another master font file (see Figures 8-

11; see Page 9, third full paragraph through Page 11, second full paragraph; see Page

12, first full paragraph through Page 14, second full paragraph – the character

processing system discloses this limitation in that it registers fonts through a user

interface by associating external character patterns, external character managing

numbers, character codes and face types into a table; thus, the character processing

system "makes it possible to confirm character shapes of master codes, as another

master font file").

Claim 7:

Yamaguchi discloses the external-character font creation system according to

Claim 3, wherein a master-font file defined within the character pattern reference file

definition table is either a master-font file by design type or a symbol master-font file

(see Figures 8 and 9; see Page 10, first and second paragraphs; see Page 11, first full

paragraph through Page 12, first partial paragraph – the character processing system

discloses this limitation in that it associates both external character files that are

classified into external characters and symbols and a plurality of master font files; thus,

the character processing system includes "master-font" files having both "design types"

and "symbols").

Claim 8:

Yamaguchi discloses the external-character font creation system according to

Claim 3, wherein a master-font file defined within the character pattern reference file

definition table is either a master-font file by design type or a master-font file of a

specific design (see Figures 8 and 9; see Page 10, first and second paragraphs; see

Page 11, first full paragraph through Page 12, first partial paragraph – the character

processing system discloses this limitation in that it associates both external character

files that are classified into external characters and symbols and a plurality of master

font files; thus, the character processing system includes "master-font" files having both

"design types" and "specific designs").

Claims 9 and 10:

These claims merely recite software that performs the functions of the external-

character font creation systems of Claims 1 and 2, respectively. Thus, Claims 9 and 10

are rejected using the same rationale discussed in the above rejections for Claims 1

and 2.

Claims 11 and 12:

These claims merely recite software that performs the functions of the external-

character font creation systems of Claim 3. Thus, Claims 11 and 12 are rejected using

the same rationale discussed in the above rejections for Claim 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure: Funyu, U.S. Patent No. 6,320,587; Mochizuki, U.S. Patent No.

5,721,812; Ooishi et al., U.S. Patent No. 5,699,524; and Ooishi, U.S. Patent No.

5,802,538.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Doug Hutton whose telephone number is (703) 305-
1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00
PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone
number for the organization where this application or proceeding is assigned is (703)
746-7239.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (703) 305-
3900.

WDH
July 17, 2004

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**